

REMARKS

Claims 9-13 and 19-46 were pending in the Application. Claim 9 is an independent claim and claims 10-13 and 39-41 depend therefrom. Claim 19 is an independent claim and claims 20-26 and 42-46 depend therefrom. Claim 27 is an independent claim and claims 28-38 depend therefrom. Claims 1-8 and 14-18 were previously canceled. Claims 9, 11, 19, 27, 40-41 and 45 are currently amended. The Applicant respectfully requests that the application be reconsidered in view of the amendments set forth above and the following remarks.

Claim Objections (Claims 9-13 and 39-41)

In point 9 on page 2 of the Office Action, claims 9-13 and 39-41 were objected to for minor informalities. The Applicant respectfully traverses the objection, however, in order to advance prosecution in the application, the Applicant has amended dependent claims 9, 11, 40 and 41 to correct the noticed minor informalities. The Applicant respectfully asserts that the minor amendment to claims 9, 11, 40 and 41 does not alter the scope of the claim as originally presented. The Applicant believes the amendments to claims 9, 11, 40 and 41 have overcome the noticed minor informalities and therefore respectfully requests that the objection to claims 9-13 and 39-41 be withdrawn.

Rejections Under 35 U.S.C. §112, Second Paragraph (Claim 45)

In point 11 on page 3 of the Office Action, claim 45 was rejected under 35 U.S.C. §112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the Office Action alleges that claim 45 “is rendered indefinite because if the model of the modem, given the broadest reasonable treatment, is interpreted as a software model of the modem, then it cannot possibly contain any

actual hardware components.” (Office Action, Page 3, Point 11). However, the Response to Arguments section of the Office Action states that “the Examiner respectfully submits that only a hardware model of the modem may contain actual hardware components.” (Office Action, Response to Arguments Section, Point 17(a), Page 31). In other words, the broadest reasonable treatment of “the model of the modem comprises an actual hardware component...” would be, as the Examiner readily acknowledges, a hardware model because “only a hardware model of the modem may contain actual hardware components.” (Office Action, Response to Arguments Section, Point 17(a), Page 31). Thus, because the broadest treatment of the model can only be interpreted as a hardware model, as explicitly acknowledged by the Examiner, one of ordinary skill in the art could not interpret the model as a software model as inconsistently alleged on page 3 of the Office Action.

Therefore, because the broadest reasonable interpretation of dependent claim 45 is that of a hardware model, dependent claim 45 is clearly not indefinite as alleged by the Office Action. Regardless, in an effort to advance prosecution in the application, the Applicant has amended dependent claim 45 to specifically indicate that the model is a hardware model, despite the fact that no other interpretation is possible because “only a hardware model of the modem may contain actual hardware components.” (Office Action, Response to Arguments Section, Point 17(a), Page 31). Therefore, the Applicant submits that the clarifying amendment of dependent claim 45 in no way narrows the scope of dependent claim 45. The Applicant respectfully submits that Applicant’s dependent claim 45 complies with 35 U.S.C. §112, second paragraph. Thus, the Applicant respectfully requests that the rejection of dependent claim 45 under 35 U.S.C. §112, second paragraph, be withdrawn.

Rejections Under 35 U.S.C. §102(e) – Abdelilah (Claims 9-13 and 39-41)

In point 13 on pages 4-8 of the Office Action, independent claim 9 and dependent claims 11-13 and 39-41 were rejected under 35 U.S.C. §102(e) as being anticipated by Abdelilah et al. (U.S. Patent No. 6,823,004, hereinafter “Abdelilah”). Without conceding that Abdelilah qualifies as

prior art under 35 U.S.C. §102(e), the Applicant respectfully traverses the rejections for at least the following reasons.

With regard to the anticipation rejections, MPEP 2131 states, “[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 2 USPQ2d 1051, 1053 (Fed.Cir. 1987). MPEP 2131 also states, “[t]he identical invention must be shown in as complete detail as is contained in the ... claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Regarding claim 9, the Applicant respectfully submits that Abdelilah fails to at least teach, suggest, or disclose, for example, “a recording module processor communicatively coupled to the first input and the second input that operates to cause **all input information arriving over a period of time at one or both of the first input and the second input during real-time operation of the modem device to be recorded** for subsequent non-real-time analysis,” as set forth in Applicant’s independent claim 9.

Abdelilah merely teaches using the DSP 340 to process and store in DSP memory 345: diagnostic data, data related to modem performance and internal state information (i.e., select data). (*See e.g.*, Abdelilah, Abstract; Column 4, Lines 62-64; Column 5, Lines 14 and 24-30; Column 8, Lines 16-19, 30-31 and 63-66; Column 9, Lines 1-4, 10-11 and 33-43; and Column 10, Lines 6-7). Nowhere in Abdelilah is there any disclosure regarding recording **all input information arriving over a period of time at one or both of the first input and the second input**. Rather, Abdelilah identifies the select data that may be obtained, for example, at Column 9, Lines 33-61. Thus, because Abdelilah merely discloses processing and storing **select data** related to diagnostics, performance and internal states, Abdelilah fails to disclose “a recording module processor communicatively coupled to the first input and the second input that operates to cause **all input information arriving over a period of time at one or both of the first input and the second input during real-time operation of the modem device to be recorded** for subsequent non-real-time analysis,” as recited by the Applicant in independent claim 9. Because the Office Action has failed to show “each and every element as set forth in the claim is found,

either expressly or inherently described, in a single prior art reference” as required for an anticipation rejection under MPEP 2131, the rejection under 35 U.S.C. § 102(e) cannot be maintained.

Therefore, for at least the above stated reasons, Applicant respectfully submits that the Abdelilah reference fails to teach, suggest, or disclose Applicant’s invention as set forth in claim 9. The Applicant believes that claim 9 is allowable over Abdelilah. Applicant respectfully submits that claim 9 is an independent claim, and that claims 10-13 and 39-41 depend either directly or indirectly from independent claim 9. Because claims 10-13 and 39-41 depend from claim 9, Applicant respectfully submits that claims 10-13 and 39-41 are allowable over the Abdelilah reference, as well. The Applicant further submits that each of claims 10-13 and 39-41 is independently allowable. The Applicant respectfully requests, therefore, that the rejection of claims 9-13 and 39-41 under U.S.C. §102(e), be withdrawn.

Rejections Under 35 U.S.C. §103(a) – Abdelilah and Kaler (Claims 19-38, 42-44 and 46)

In point 15 on pages 9-29 of the Office Action, independent claims 19 and 27, and dependent claims 20-26, 28-38, 42-44 and 46 were rejected under 35 U.S.C. §103(a) as being unpatentable over Abdelilah in view of Kaler et al. (U.S. Patent No. 6,467,052, hereinafter “Kaler”). The Applicant respectfully traverses the rejection for at least the following reasons.

In order for a *prima facie* case of obviousness to be established, the Manual of Patent Examining Procedure, Rev. 6, Sep. 2007 (“MPEP”) states the following:

The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385, 1396 (2007) noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit. The Federal Circuit has stated that "rejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness."

See the MPEP at § 2142, citing *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006), and *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d at 1396 (quoting Federal Circuit statement with approval). Further, MPEP § 2143.01 states that “the mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art” (citing *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385, 1396 (2007)). Additionally, if a *prima facie* case of obviousness is not established, the Applicant is under no obligation to submit evidence of nonobviousness:

The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.

See MPEP at § 2142.

Regarding claim 19, Applicant respectfully submits that the combination of Abdelilah and Kaler at least fails to teach, suggest, or disclose at least, for example, “a memory comprising **all input information, received over a period of time by a modem**, that was recorded by a recording module residing on the modem during real-time operation of the modem,” as set forth in Applicant’s independent claim 19.

As mentioned above with regard to Applicant’s independent claim 9, Abdelilah fails to disclose “a memory comprising **all input information, received over a period of time by a modem**, that was recorded by a recording module residing on the modem during real-time operation of the modem,” as set forth in Applicant’s independent claim 19. Abdelilah merely teaches using the DSP 340 to process and store in DSP memory 345: diagnostic data, data related to modem performance and internal state information (i.e., select data). (See *e.g.*, Abdelilah, Abstract; Column 4, Lines 62-64; Column 5, Lines 14 and 24-30; Column 8, Lines 16-19, 30-31 and 63-66; Column 9, Lines 1-4, 10-11 and 33-43; and Column 10, Lines 6-7). Nowhere in Abdelilah is there any disclosure regarding a memory comprising **all input information** arriving over a period of time at a modem. Rather, Abdelilah identifies the select data that may be obtained, for example, at Column 9, Lines 33-61. Thus, because Abdelilah merely discloses

processing and storing **select data** related to diagnostics, performance and internal states, Abdelilah fails to disclose “a memory comprising **all input information, received over a period of time by a modem**, that was recorded by a recording module residing on the modem during real-time operation of the modem,” as recited by the Applicant in independent claim 19. Kaler fails to remedy the deficiencies of Abdelilah. Thus, because the combination of Abdelilah in view of Kaler fails to teach the limitations of Applicant’s independent claim 19, the rejection under 35 U.S.C. § 103(a) cannot be maintained.

Therefore, for at least the above stated reasons, Applicant respectfully submits that Applicant’s claim 19 is allowable over the combination of Abdelilah and Kaler. Applicant respectfully submits that claim 19 is an independent claim, and that claims 20-26 and 42-46 depend either directly or indirectly from independent claim 19. Because claims 20-26 and 42-46 depend from claim 19, Applicant respectfully submits that claims 20-26 and 42-46 are allowable over the combination of Abdelilah and Kaler, as well. The Applicant further submits that each of claims 20-26 and 42-46 is independently allowable. The Applicant respectfully requests, therefore, that the rejections of claims 19-26, 42-44 and 46 under U.S.C. §103(a), be withdrawn.

Turning next to claim 27, Applicant respectfully submits that the combination of Abdelilah and Kaler at least fails to teach, suggest, or disclose at least, for example, “while operating the modem in real-time, utilizing the recording module to cause the **recording of all input information input to at least the first and/or second inputs of the modem over a period of time**,” as set forth in Applicant’s independent claim 27.

As mentioned above with regard to Applicant’s independent claims 9 and 19, Abdelilah fails to disclose “while operating the modem in real-time, utilizing the recording module to cause the **recording of all input information input to at least the first and/or second inputs of the modem over a period of time**,” as set forth in Applicant’s independent claim 27. Abdelilah merely teaches using the DSP 340 to process and store in DSP memory 345: diagnostic data, data related to modem performance and internal state information (i.e., select data). (*See e.g.*,

Abdelilah, Abstract; Column 4, Lines 62-64; Column 5, Lines 14 and 24-30; Column 8, Lines 16-19, 30-31 and 63-66; Column 9, Lines 1-4, 10-11 and 33-43; and Column 10, Lines 6-7). Nowhere in Abdelilah is there any disclosure regarding recording **all** input information arriving over a period of time at one or both of the first input and the second input. Rather, Abdelilah identifies the select data that may be obtained, for example, at Column 9, Lines 33-61. Thus, because Abdelilah merely discloses processing and storing **select data** related to diagnostics, performance and internal states, Abdelilah fails to disclose “while operating the modem in real-time, utilizing the recording module to cause the **recording of all input information input to at least the first and/or second inputs of the modem over a period of time,**” as recited by the Applicant in independent claim 27. Kaler fails to remedy the deficiencies of Abdelilah. Thus, because the combination of Abdelilah in view of Kaler fails to teach the limitations of Applicant’s independent claim 27, the rejection under 35 U.S.C. § 103(a) cannot be maintained.

Therefore, for at least the above stated reasons, Applicant respectfully submits that Applicant’s claim 27 is allowable over the combination of Abdelilah and Kaler. Applicant respectfully submits that claim 27 is an independent claim, and that claims 28-38 depend either directly or indirectly from independent claim 27. Because claims 28-38 depend from claim 27, Applicant respectfully submits that claims 28-38 are allowable over the combination of Abdelilah and Kaler, as well. The Applicant further submits that each of claims 28-38 is independently allowable. The Applicant respectfully requests, therefore, that the rejections of claims 27-38 under U.S.C. §103(a), be withdrawn.

Rejections Under 35 U.S.C. § 103(a) – Abdelilah, Kaler and Read (Claim 45)

In point 16 on pages 29-30 of the Office Action, claim 45 was rejected under 35 U.S.C. §103(a) as being unpatentable over Abdelilah in view of Kaler and further in view of Read et al. (U.S. Patent No. 5,353,243, hereinafter “Read”). The Applicant respectfully submits that claim 45 depends either directly or indirectly from independent claim 19. Applicant believes that claim 19 is allowable over the proposed combination of references, in that Read fails to overcome the

deficiencies of Abdelilah in view of Kaler, as set forth above. Because claim 45 depends from independent claim 19, Applicant respectfully submits that claim 45 is allowable over the proposed combination of Abdelilah, Kaler and Read, as well. Applicant also asserts that claim 45 is independently allowable. Therefore, for at least the reasons set forth above, Applicant respectfully requests that the rejection of claim 45 under 35 U.S.C. §103(a) be withdrawn.

Final Matters

The Office Action makes various statements regarding claims 9-13 and 19-46, 35 U.S.C. § 112, Second Paragraph, 35 U.S.C. § 102(e), 35 U.S.C. § 103(a), the Abdelilah reference, the Kaler reference, the Read reference, one of skill in the art, etc. that are now moot in view of the above amendments and/or arguments. Thus, the Applicant will not address all of such statements at the present time. However, the Applicant expressly reserves the right to challenge such statements in the future should the need arise (e.g., if such statements should become relevant by appearing in a rejection of any current or future claim).

Applicant reserves the right to argue additional reasons supporting the allowability of claims 9-13 and 19-46 should the need arise in the future.

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Response dated August 17, 2009

CONCLUSION

Applicant respectfully submits that claims 9-13 and 19-46 are in condition for allowance, and requests that the application be passed to issue.

Should anything remain in order to place the present application in condition for allowance, the Examiner is kindly invited to contact the undersigned at the telephone number listed below.

Please charge any required fees not paid herewith or credit any overpayment to the Deposit Account of McAndrews, Held & Malloy, Ltd., Account No. 13-0017.

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Respectfully submitted,

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